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EXAMINER

BLAU, STEPHEN LUTHER

ART UNIT PAPER NUMBER

3711

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/668,139

Applicant(s)

SUGIMAE ET AL.

Examiner

Stephen L. Blau

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-17 and 25-28 is/are pending in the application.
- 4a) Of the above claim(s) 12 and 13 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2 and 4-8 is/are allowed.
- 6) ☒ Claim(s) 9 and 24-28 is/are rejected.
- 7) ☒ Claim(s) 10-11 and 14-17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

1. The change to claim 6 is agreed with and the objection to the drawings is disagreed with.

### ***Claim Rejections - 35 USC § 112***

2. The change to claim 6 is agreed with and the rejection under 35 U.S.C. 112, first paragraph, is removed.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Risher in view of Tsuchida and admitted prior art (previous Examiner's Official Notice).

With respect to claim 9, Risher discloses a ferrule having a lower portion configured to receive an end of a hosel (Fig. 4), a lower portion including an annular

Art Unit: 3711

ridge (42) positioned in the axial bore and configured to cooperate with an annular recess (40) defined in an outer surface of a hosel to inhibit longitudinal movement of the ferrule (Fig. 4) and a lower portion having an interior surface about an axial bore configured to cooperate with the end of the hosel to inhibit axial rotation of the ferrule in the form of the ridge (rib) and recess (groove) filled with adhesive material (Col. 2, Lns. 31-34). Risher lacks surfaces to engage each other in an interlocking fit that inhibits axial rotation as well as longitudinal movement. Tsuchida discloses a ferrule and hosel having surfaces configured to engage each other with one embodiment being an annular ridge and recess (Fig. 2) as Risher discloses and a second embodiment of a number of projections and recesses (Fig. 4, Col. 3, Lns. 20-30) in an interlocking fit that inhibits axial rotation and longitudinal movement (Fig. 4) in order to prevent accidental separation of a ferrule (Col. 1, Lns. 35-40). In view of the patent of Tsuchida it would have been obvious to modify a golf club of Risher to have a ferrule and hosel having surfaces configured to engage each having a number of projections and recesses in an interlocking fit that inhibits axial rotation and longitudinal movement in order to prevent accidental separation of a ferrule.

The applicant has admitted by not arguing the Examiner's Official Notice that it is well known in the prior art and obvious to have in a club a shaft having an upper end adapted to be gripped by a golfer.

5. Claim 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Risher in view of Tsuchida.

With respect to claims 25 and 27, Risher discloses a body having a lower portion in the form of the part of the ferrule (30) below the projecting rib (42) and an upper portion which includes the rib (42) and above (Fig. 4), the lower portion configured to receive an end of a hosel (Fig. 2), the upper portion having a ridge positioned on an interior surface of an axial bore (Fig. 4), and the upper portion having a first diameter that is smaller than a second diameter at a lower portion (Fig. 4). Risher lacks an upper portion having a plurality of protrusions positioned on an interior surface of an axial bore. Tsuchida discloses a ferrule and hosel having surfaces configured to engage each other with one embodiment being an annular ridge and recess (Fig. 2) as Risher discloses and a second embodiment of a number of projections and recesses (Fig. 4, Col. 3, Lns. 20-30) in an interlocking fit that inhibits axial rotation and longitudinal movement (Fig. 4) in order to prevent accidental separation of a ferrule (Col. 1, Lns. 35-40). In view of the patent of Tsuchida it would have been obvious to modify a golf club of Risher to have an upper portion having a plurality of protrusions positioned on an interior surface of an axial bore to fit in a plurality of recesses in an outer surface of a hosel in order to prevent accidental separation of a ferrule.

6. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Risher in view of Tsuchida as applied to claims 25 and 27 above, and further in view of Johnson.

Risher lacks a chamfer surface at a bottom end of the body. Johnson discloses a ferrule having a chamfer surface at a bottom end of the body inside the bore (Fig. 9). In view of the patent of Johnson it would have been obvious to modify the ferrule of

Art Unit: 3711

Risher to have a chamfer surface at a bottom end of the body inside the bore in order to guide the end of the hosel into the ferrule bore.

7. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Risher in view of Tsuchida as applied to claims 25 and 27 above, and further in view of Butler (5,797,806).

Risher discloses a ferrule being an elastomer (Col. 2, Lns. 13-16).

Risher lacks a ferrule formed with a density less than 2 g/cc and a modulus of elasticity no greater than about 3 Gpa.

Butler discloses a ferrule being an elastomer and preferably formed of Delrin or Nylon (Abstract). Butler does not disclose the density or elasticity of the ferrule but clearly one skilled in the art of forming an elastic ferrule which is light weight would have selected suitable properties in which a density less than 2 g/cc and a modulus of elasticity no greater than about 3 Gpa are included. In view of the patent of Butler it would have been obvious to modify the ferrule of Risher to be made of Delrin or Nylon in order to utilize an elastomer material used in the market place for ferrules. It would have been obvious to modify the ferrule of Risher to have a density less than 2 g/cc in order to minimize weight added to a club. It would have been obvious to modify the ferrule of Risher to have and a modulus of elasticity no greater than about 3 Gpa in order to be able to stretch the ferrule over the hosel and place the rib in the groove.

***Allowable Subject Matter***

8. Claims 1-2 and 4-8 are allowed. With respect to claims 1-2 and 4-8, none of the prior art discloses or renders as obvious an upper portion including a plurality of protrusions and a lower portion having an interior surface about the axial bore configured to cooperate with the end of the hosel to inhibit axial rotation of the ferrule about the hosel in addition to the other elements of structure claimed.

9. Claims 10-11 and 14-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. With respect to claim 10, none of the prior art discloses or renders as obvious an annular ridge to cooperate with an annular recess of a hosel, corresponding surfaces configured to engage each other in an interlocking fit that inhibits axial rotation in addition to the other elements of structure claimed. With respect to claim 11, none of the prior art discloses or renders as obvious an upper portion including a plurality of protrusions in addition to the other elements of structure claimed. With respect to claims 14-17, none of the prior art discloses or renders as obvious a longitudinal rib on an interior surface of a ferrule and a corresponding groove on the outer surface of a hosel in addition to the other elements of structure claimed.

***Response to Arguments***

10. Applicant's arguments with respect to claims 9-10 have been considered but are moot in view of the new ground(s) of rejection.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.



***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen L. Blau whose telephone number is (571) 272-4406. The examiner can normally be reached on Mon - Fri 10:00 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on (571) 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SLB/20 January 2006

  
**STEPHEN BLAU**  
**PRIMARY EXAMINER**